

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS AND INTERFERENCES**

In Re Application of:

Confirmation No.: 6302

Anthony J. Wasilewski

Group Art Unit: 2431

Serial No.: 10/602,987

Examiner: Chai, Longbit

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Docket No.: A-8919/60374.0029USC4

For: Method for Partially Encrypting Program Data

APPEAL BRIEF UNDER 37 C.F.R. §1.192

Mail Stop Appeal Brief - Patents
Commissioner of Patents and Trademarks
P.O. Box 1450
Alexandria, Virginia 22313-1450

Sir:

This is an appeal from the Final Office Action dated April 2, 2009, which rejected claims 1-19 in the present application.

I. REAL PARTY IN INTEREST

The real party in interest of the instant application is Scientific-Atlanta, Inc., having its principal place of business at 5030 Sugarloaf Parkway, Lawrenceville, GA 30044. Scientific-Atlanta, Inc., the assignee of record, is wholly owned by Cisco Systems, Inc.

II. RELATED APPEALS AND INTERFERENCES

Concurrently with the filing of this Appeal Brief is the filing of Appeal Briefs in related Application Nos. 10/602,986 and 10/602,988.

III. STATUS OF THE CLAIMS

Claims 1-19 currently stand rejected. Appellants appeal the final rejection of claims 1-19.

IV. STATUS OF AMENDMENTS

No amendments have been made or requested since the mailing of the Final Office Action and all amendments submitted prior to the Final action have been entered. The claims in the attached Claims Appendix (see below) reflect the present state of Appellants' claims.

V. SUMMARY OF CLAIMED SUBJECT MATTER

The claimed subject matter is summarized below with reference numerals and references to the written description ("specification") and drawings. The subject matter, described in the following, appears in the original disclosure at least where indicated, and may further appear in other places within the original disclosure.

Embodiments of the claimed subject matter are illustrated in FIGs. 1-29 and are discussed in the specification at least in pages 1-71.

Embodiments of the claimed subject matter, such as those defined by claim 1, define a method for providing a plurality of programs in a conditional access system, the method comprising the steps of: using a packet identifier to select for encryption a portion of each of a plurality of digital bit streams from a transport stream (see, e.g., page 13, lines 6-16; FIG. 3); encrypting a portion of each of the plurality of digital bit streams (see, e.g., p. 28, lines 15-22); combining the encrypted portion and the unencrypted portion with the transport stream (see, e.g., page 13, lines 6-16; FIG. 3); and transmitting the combined stream (see, e.g., page 13, lines 14-16; FIG. 3).

Embodiments of the claimed subject matter, such as those defined by claim 13, define a method for providing a plurality of programs in a conditional access system, the method comprising the steps of: using an identifier to select for encryption a portion of a plurality of elementary bit streams from a plurality of programs (see, e.g., page 13, lines 6-16; FIG. 3); encrypting the selected portion of the streams (see, e.g., p. 28, lines 15-22); combining the encrypted portion and the remaining portion of the streams with the plurality of programs to provide a partially-encrypted stream (see, e.g., page 13, lines 6-16; FIG. 3); and transmitting the partially-encrypted stream (see, e.g., page 13, lines 14-16; FIG. 3).

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

Claims 1-19 stand rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by U.S. Patent No. 7,376,233 ("*Candalore*") with *incorporated by reference* of U.S. Pat. Pub. No. 2003/0026423 ("*Unger*").

VII. ARGUMENT

In the present case, it is respectfully submitted that a *prima facie* case for anticipation is not established using the art of record. For at least the reasons set forth below, Appellants respectfully request that the Board of Patent Appeals overturn the final rejection of those claims.

Pages 2-3 of the Final Office action allege that the application pertaining to the beneficial priority date fails to "support the disclosure of using a packet identifier to select for partial encryption". (emphasis in original).

Appellants respectfully disagree with the above allegations of non-support from the Final Office Action. In addition, in view of the non-final Office Action of November 8, 2007, it appears

that the denial of the beneficial priority date is based on 35 U.S.C. §112(1), and hence from page 2 of the non-final Office Action dated November 18, 2008, the effective filing date alleged for the present claims is June 25, 2003. (*See also*, Final Office Action, p.3).

Further, the Final Office Action summary referenced and reproduced in part above makes mention of previously filed declarations for other cases. Appellants respectfully note that for the present case, the rejection is improper. That is, for a proper rejection under 35 U.S.C. §112(1), MPEP 2163 provides as follows:

The examiner has the initial burden of presenting evidence or reasoning to explain why persons skilled in the art would not recognize in the original disclosure a description of the invention defined by the claims. See *Wertheim*, 541 F.2d at 263, 191 USPQ at 97 ("[T]he PTO has the initial burden of presenting evidence or reasons why persons skilled in the art would not recognize in the disclosure a description of the invention defined by the claims."). However, when filing an amendment an applicant should show support in the original disclosure for new or amended claims.

Appellants respectfully submit that the present rejection has not met the *initial* burden established under MPEP 2163 for rejecting the priority claim, and hence the rejection is deficient in that regard. Nevertheless, in the interest of advancing prosecution on the merits, Appellants address where support can be found in the specification for the current claim language. MPEP 2163 provides the following guidelines for 35 U.S.C. §112(1) with respect to priority dates:

To comply with the written description requirement of 35 U.S.C. 112, para. 1, or to be entitled to an earlier priority date or filing date under 35 U.S.C. 119, 120, or 365(c), each claim limitation must be expressly, implicitly, or inherently supported in the originally filed disclosure. When an explicit limitation in a claim "is not present in the written description whose benefit is sought it must be shown that a person of ordinary skill would have understood, at the time the patent application was filed, that the description requires that limitation." *Hyatt v. Boone*, 146 F.3d 1348, 1353, 47 USPQ2d 1128, 1131 (Fed. Cir. 1998).

As the Final Office Action alleges priority issues with the first element of claim 1, as an illustrative example, Appellants address that element below in the context of the written

description requirement. Claim 1 requires "using a packet identifier to select for encryption a portion of each of a plurality of digital bit streams from a transport stream". Appellants wish to draw attention to page 13, lines 6-16 of the specification, which is used in conjunction with Figure 3. Figure 3 and the above-noted specification portion reveals a digital bit stream (e.g., transport stream) comprising ECM encrypted according to 3DES (e.g., 321) and audio/video/data content coded according to DES (e.g., 327). Such a disclosure would be readily evident to one having ordinary skill in the art that different encryption methods for the same stream, different portions, are contemplated. In addition, page 27 of the specification (lines 19-29), used in conjunction with Figure 7, describes detailed mechanisms of MPEG transport, and in particular, the fact that "any part or all of MPEG transport stream" may be encrypted, revealing to one having ordinary skill in the art that the stream may comprise clear and encrypted portions (i.e., partially encrypted). Note that one encryption method is described as the DES algorithm (for the program), and on page 28, lines 15-22, the ECMs are encrypted according to a different method (3DES), consistent with the previously described portions of the specification pertaining to Figure 3.

Accordingly, it is clear that the specification supports the above-recited claim 1 elements, and to the extent such elements are found in identical or similar form in claim 13, Appellants respectfully request that the priority denial be withdrawn. In addition, since the current application is a continuation along a line of continuations having an effective priority date of July 8, 1998, the effective filing date at least goes back to July 8, 1998. Although Appellants respectfully disagree with the allegations pertaining to the alleged unpersuasiveness of the affidavits in related cases (and hence believe priority can be dated back to the provisional application date of August 1, 1997), the issue of support in the provisional is moot for purposes of the present rejection and the *Candelore* and *Unger* references.

1. Rejection of Claims 1-19 under 35 U.S.C. §102(e)

Claims 1-19 have been rejected under §102(e) as allegedly anticipated by *Candelore et al.* (U.S. 7,376,233, herein, "*Candelore*") with incorporated by reference *Unger et al.* ("*Unger*," U.S. Patent Pub. 2003/0026423). Appellants respectfully traverse this rejection. In particular, since the claims of the present application enjoy the benefit of a filing date that predates the effective filing date of *Candelore* (and *Unger*), the art of record does not represent anticipatory subject matter, and accordingly, the rejection should be withdrawn.

For at least the reason that independent claims 1 and 13 are allowable over the cited references of record, respective dependent claims 2-12 and 14-19 are allowable as a matter of law.

VIII. CLAIMS - APPENDIX

1. (Previously Presented) A method for providing a plurality of programs in a conditional access system, the method comprising the steps of:

using a packet identifier to select for encryption a portion of each of a plurality of digital bit streams from a transport stream;

encrypting a portion of each of the plurality of digital bit streams;

combining the encrypted portion and the unencrypted portion with the transport stream;

and

transmitting the combined stream.

2. (Previously Presented) The method of claim 1, wherein each of the plurality of digital bit streams includes a packet identifier, and wherein using a packet identifier to select for encryption selects a portion of each of the plurality of digital bit streams by identifying a predetermined packet identifier.

3. (Previously Presented) The method of claim 1, wherein each of the plurality of digital bit streams includes a packet identifier, and wherein using a packet identifier to select for encryption selects the plurality of digital bit streams by identifying a plurality of predetermined packet identifiers.

4. (Original) The method of claim 3, wherein the selected plurality of digital bit streams are programs.

5. (Original) The method of claim 3, wherein the selected plurality of digital bit streams are elementary digital bit streams.

6. (Previously Presented) The method of claim 3, wherein a portion of the selected plurality of digital bit streams is encrypted according to the packet identifier associated with each of the plurality of digital bit streams.

7. (Previously Presented) The method of claim 6, wherein the packet identifier is indicative of each of the plurality of digital bit streams being one of a video stream, an audio stream, and a data stream.

8. (Original) The method of claim 7, wherein the encrypted portion includes at least one of the plurality of digital bit streams associated with the video stream.

9. (Original) The method of claim 7, wherein the encrypted portion includes at least one of the plurality of digital bit streams associated with the audio stream.

10. (Original) The method of claim 7, wherein the encrypted portion includes at least one of the plurality of digital bit streams associated with the data stream.

11. (Original) The method of claim 7, wherein the encrypted portion includes at least one of the plurality of digital bit streams associated with at least one of the video stream, the audio stream, and the data stream.

12. (Original) The method of claim 1, wherein the portion of the plurality of digital bit streams is encrypted according to a first level encryption method.

13. (Previously Presented) A method for providing a plurality of programs in a conditional access system, the method comprising the steps of:

using an identifier to select for encryption a portion of a plurality of elementary bit streams from a plurality of programs;

encrypting the selected portion of the streams;
combining the encrypted portion and the remaining portion of the streams with the plurality of programs to provide a partially-encrypted stream; and
transmitting the partially-encrypted stream.

14. (Original) The method of claim 13, wherein each of the plurality of elementary bit streams includes a plurality of packets, each packet having a packet header.

15. (Previously Presented) The method of claim 14, wherein the packet header includes a packet identifier identifying the packet, wherein the packet identifier is indicative of one of a video stream, an audio stream, and a data stream.

16. (Original) The method of claim 15, wherein the encrypted portion includes at least one of the plurality of packets associated with the video stream.

17. (Original) The method of claim 15, wherein the encrypted portion includes at least one of the plurality of packets associated with the audio stream.

18. (Original) The method of claim 15, wherein the encrypted portion includes at least one of the plurality of packets associated with the data stream.

19. (Original) The method of claim 15, wherein the encrypted portion includes at least one of the plurality of packets associated with at least one of the video stream, the audio stream, and the data stream.

IX. EVIDENCE - APPENDIX

None.

IX. RELATED PROCEEDINGS- APPENDIX

None.